

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

To:

see form PCT/ISA/220

PCT

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

Date of mailing
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference
see form PCT/ISA/220

FOR FURTHER ACTION
See paragraph 2 below

International application No.
PCT/GB2004/001700

International filing date (day/month/year)
21.04.2004

Priority date (day/month/year)
22.04.2003

International Patent Classification (IPC) or both national classification and IPC
A61B3/113, A61B3/024

Applicant
MCGRATH, John Andrew Murray

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☒ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA:



European Patent Office - Gitschiner Str. 103
D-10958 Berlin
Tel. +49 30 25901 - 0
Fax: +49 30 25901 - 840

Authorized Officer

Clevorn, J

Telephone No. +49 30 25901-556



WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITYInternational application No.
PCT/GB2004/001700

IC20 Rec'd PCTO 20 OCT 2005

Box No. I Basis of the opinion

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
 - ☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material:
 - ☐ a sequence listing
 - ☐ table(s) related to the sequence listing
 - b. format of material:
 - ☐ in written format
 - ☐ in computer readable form
 - c. time of filing/furnishing:
 - ☐ contained in the international application as filed.
 - ☐ filed together with the international application in computer readable form.
 - ☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/GB2004/001700

Box No. II Priority

1. ☒ The following document has not been furnished:

☒ copy of the earlier application whose priority has been claimed (Rule 43*bis*.1 and 66.7(a)).

☐ translation of the earlier application whose priority has been claimed (Rule 43*bis*.1 and 66.7(b)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date is the claimed priority date.

2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43*bis*.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.

3. Additional observations, if necessary:

Box No. V Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

| | | |
|-------------------------------|-------------|--------------------|
| Novelty (N) | Yes: Claims | 1-43 |
| | No: Claims | |
| Inventive step (IS) | Yes: Claims | 4-13, 16-21 |
| | No: Claims | 1-3, 14, 15, 22-43 |
| Industrial applicability (IA) | Yes: Claims | 1-43 |
| | No: Claims | |

2. Citations and explanations

see separate sheet

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING
AUTHORITY (SEPARATE SHEET)**

International application No.

PCT/GB2004/001700

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Reference is made to the following documents:

D1: US5920375

D2: US6367932

2. The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claims 1, 24 and 43 does not involve an inventive step in the sense of Article 33(3) PCT.

- 2.1. The document D1 discloses (the references in parentheses applying to this document):

A method of assessing eye function, comprising

(a) providing an image area (4) in which images can be presented to the eye

(b) forming a fixation image (FP1, fig. 1)

(c) presenting a stimulus to the eye at a location within the image area spaced from the fixation image (FP1', fig. 2)

(d) detecting a saccade triggered by said stimulus (col. 3, li. 7-8) and immediately removing the original fixation image and creating a new fixation image at said location (col. 3, li. 8-11; col. 2, li. 7-9);

(e) recording the saccade (col. 3, li. 7-8) and (implicitly) the subsequent fixation

(f) repeating steps (c) to (e) (col. 3, li. 16-19)

The feature in step (a), that the luminance of any point in the area over the desired field of view under test can be defined at least as accurately as the desired accuracy of a retinal map to be obtained is unclear (Art. 6 PCT) and cannot be used to delimit the claim from the prior art. This applies to the terms desired field of view and desired accuracy, and the definition of the luminance by referring to the accuracy of a retinal map, which is not part of the claim. D1 discloses that the luminance can be adjusted (col. 1, li. 65-col. 2, li. 2; col. 2, li. 20-30).

Referring to step (e), it is normal practice for the skilled person in eye examination,

that when recording a saccade, both the timing (e. g. time of onset) and magnitude (e. g. coordinates of fixation before and after the saccade) are recorded.

Referring to step (g), it likewise considered to be normal practice in eye examination to compare the results (e. g. a determined field of view) with a database of eye responses (e. g. of average responses in a population or of previously determined responses of the same person).

Claim 1 thus lacks inventive step.

- 2.2. Claims 24 and 43 are not inventive for like reasons. With reference to claim 24, it is noted that any conventional apparatus for use in assessing eye functions and comprising features (a)-(c) and means for detecting and recording saccades would also be suitable for removing initial and creating new fixation images. A formulation like "comprising a computer configured to ..." could overcome this point.

3. As to the dependent claims

Dependent claims 2, 3, 14, 15, 22, 23 and 25-42 do not appear to contain any additional features which meet the requirements of the PCT with respect to inventive step.

In particular, the features of claims 2, 14, 15, 23, 25 are merely straightforward possibilities, which the skilled person would select, in accordance with circumstances, without the exercise of inventive skill, in order to solve the problem posed. They come within the scope of the customary practice followed by persons skilled in the art, especially as the advantages thus achieved can be readily contemplated in advance.

References to properties of the human eye cannot be used to delimit a claim from the prior art, such as in claims 3, 22, 26, 35, 36, 41 and 42. The same applies to terms like high or numbers preceded by approximately and to features in an apparatus claim described as steps in a method of using the apparatus.

It is further noted that any apparatus as mentioned in point 2.2. of this

communication would obviously have a computer suitable for performing the calculations mentioned in the apparatus claims. Again, a formulation like "comprising a computer configured to ..." could overcome this point.

4. Independent claims should be in the two-part form in accordance with Rule 6.3(b) PCT.

The features of the claims should be provided with reference signs placed in parentheses to increase the intelligibility of the claims (Rule 6.2(b) PCT).

5. If amendments are filed, the description, in particular the statement of invention, should be brought into conformity with the amended claims. To meet the requirements of Rule 5.1(a)(ii) PCT, the documents D1 and D2 should be identified in the description and the relevant background art disclosed therein should be briefly discussed.
6. If amendments are filed, the applicant is requested to effect the amendments by filing replacement pages for only those pages which have been amended. Unnecessary recasting of the description should be avoided. In order to facilitate the examination of the conformity of the amended application with the requirements of Article 19(2) PCT, the applicant is requested to *clearly identify the amendments carried out, irrespective of whether they concern amendments by addition, replacement or deletion, and to indicate the passages of the application as filed on which these amendments are based*. Without such indications, the amendments might not be taken into account by the IPEA when drawing up the International Preliminary Examination Report.